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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/137,503	08/20/98	GRAEF P	WEYC111558

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EXAMINER	
SHANOSKI,P	
ART UNIT	**PAPER NUMBER**
3761	5

DATE MAILED: 10/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/137,503	Peter A. Graef et al.
Examiner	**Group Art Unit**
Paul Shanoski	3761

☒ Responsive to communication(s) filed on *Aug 20, 1998* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-61* is/are pending in the application.

Of the above, claim(s) *34-61* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-33* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

DETAILED ACTION

Election/Restriction

Claims 1-61 are generic to a plurality of disclosed patentably distinct species comprising an absorbent composite, an absorbent article that includes the composite, and a method for forming the composite. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with George E. Renzoni, Ph.D., on September 27, 1999, a provisional election was made without traverse to prosecute the invention of the elected species, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-61 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Brassington et al., International Patent Publication Number WO 96/07783.

Brassington describes a first layer having hydrophobic fibers (page 6, lines 2-3) and a binder (page 5, line 15), a second layer containing hydrophilic fibers (page 3, lines 11-13), and a transition zone between the first and second layers which has fibers from each extending into the other (page 3, lines 22-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al., P.N. 4,145,464.

McConnell teaches an absorbent structure having a first layer containing hydrophobic fibers (column 5, line 49), a second layer having hydrophilic fibers (column 3, line 28), and a transition zone between the two with fibers from each extending into the other (column 5, lines 61-65). The reference does not teach the use of a binder in the first layer. The use of a binder as an additive to affect the material properties of the desired end product is well known in the art. Ordinary workers in the field of absorption would recognize the benefit of using a binder as an additive. Therefore, it would have been obvious to one of ordinary skill in the art to modify the McConnell reference to arrive at the claimed invention. See In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

Claim 32 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brassington et al. As stated previously, Brassington teaches an absorbent structure containing a hydrophobic first layer, a hydrophilic second layer, and a transition zone between the two. The claimed invention involves the use of polyethylene terephthalate fibers and bicomponent binding fibers in the first layer, and cross linked cellulose fibers with a wet strength agent in the second. Polyethylene terephthalate is a polyester, the fibers of which are hydrophobic. The Brassington reference teaches a small genus which places the claimed species in possession of the public. See In re Schaumann, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 USC 102. Additionally, Cellulose is commonly used as an absorbent, and the use of wet strength agents is well known in the art. Therefore, one of ordinary skill in the art would have been able to read Brassington and arrive at the claimed invention.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brassington. Brassington teaches an absorbent structure containing a hydrophobic first layer, a hydrophilic second layer, and a transition zone between the two. It does not teach the use of a binder in the second layer, nor does it specify that the two layers must be foam-formed. However, the use of a binder as an additive, and the method of foam-forming stratified tissues and webs, are both well known in the art. It follows that one of ordinary skill in the art would have been able to arrive at the claimed invention after reading the Brassington reference.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Heiman, P.N. 5,290,269 and Brohammer et al, P.N. 5,653,702 .

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shanoski whose telephone number is (703) 305-0560. If he is unable to be reached, you may contact his supervisor, John Weiss, at (703) 308-2702.

The fax number for official papers for this Group is (703) 305-3590. The fax number for unofficial papers for this Unit is (703) 306-4520.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Paul Shanoski

September 30, 1999

John G. Weiss
Supervisory Patent Examiner
Group 3700